

REMARKS

Claims 1-30 are pending. By this response, claims 1-20, 23-26, 29 and 30 are amended. Reconsideration and allowance based on the above-amendments and following remarks are respectfully requested.

Prior to addressing the specific rejection, applicants provide the following brief summary of embodiments of applicant's invention. Applicants provide a pen that is able to record the writings performed by the pen. The pen contains an internal memory for storing the recorded information. However, the internal memory limits the amount of data recorded during the writing that can be stored. Thus, a second memory is provided which is external to the pen in which information stored in the internal memory of the pen is automatically transferred to the second external memory. Therefore, the recorded information will never exceed the storage capacity of the internal memory of the pen. Thus, the internal memory and external memory act together such that they are perceived by user as being one memory. This allows the user to operate the pen as if it has essentially unlimited memory capacity.

The Office Action rejects claims 1-30 under 35 U.S.C. §103(a) as being unpatentable over Lazzouni, et al. (U.S. Patent No. 5,661,506) in view of O'Conner (U.S. Patent No. 6,188,392). This rejection is respectfully traversed.

The Examiner alleges that Lazzouni discloses each of applicant's claimed features as recited in independent claims 1, 15, 18, 26 and 30 except for the use

of an internal memory. The Examiner alleges that O'Conner makes up for this deficiency and that the combination of Lazzouni and O'Conner's teachings provide applicant's claimed features. Applicants respectfully disagree.

Lazzouni discloses the use of a pure imaging pen. The pen in Lazzouni includes an attached imaging system that generates images of the writings created by the pen and outputs these writings to an external recording/processing unit. See Figs. 10-12 and column 4, lines 22-26. The receiving unit then processes the images to obtain positioned information that reflects the movement pattern of the imaging pen. This information is then stored in a memory 146. See Figs. 10-11, column 9, lines 6-47. Lazzouni's system, as recognized by the Examiner, fails to teach or suggest using a pen having an internal memory of which the Examiner alleges O'Conner provides.

O'Conner, however, discloses the use of an electronic pen having internal accelerometers. The pen samples data from the accelerometers and stores intermediate data representative of the X, Y acceleration and pressure, in an internal memory unit. The intermediate data is later processed into position data in an external processing device. See column 4, lines 32-37 and column 5, lines 8-12. As illustrated in Fig. 2 of O'Conner, the pen can communicate with an external device either via a docking station or via a wireless communications interface. In each of these operations, a user controls the transmission of the data from the internal memory of the pen to an external device. O'Conner does not

teach or suggest the automatic transfer of data in an internal memory of a pen to an external memory. In fact, O'Conner suggests that the memory capacity of a pen should include enough memory to store data of most users over the course of the day. See column 1, lines 50-55. Thus, O'Conner implies that the content of the memory in the pen of O'Conner is transferred to the external device at a time of the users choosing, i.e. whenever the user has the opportunity to perform a physical or wireless docking operation.

Thus, neither Lazzouni nor O'Conner in combination or alone teach all of the features of the claimed invention. Specifically, within Lazzouni, the internal memory of the pen is not taught and within O'Conner, the amount of data recorded is limited to the capacity of the memory within the pen and the data is not automatically transferred to an external memory.

Thus, the combination of Lazzouni and O'Conner fail to teach or suggest in the pen device environment, *inter alia*, a first memory unit located in the pen device and a second memory unit located in an external data storage device, which memory units are connected in such a way that through transmission of the recorded information from the first memory to the second, the recorded information can exceed the storage capacity of the first memory and thereby, from the point of view of the user, the first memory and second memory form a coherent memory unit, as recited in claims 1, 15, 18 and 30.

Also, the combination of Lazzouni and O'Conner fail to teach or suggest, *inter alia*, reserving memory capacity for the pen device in an external data storage device, receiving, automatically, recorded information from a memory located in the pen device and storing the same in external data storage device, and sending the recorded information to an information management unit in response to a "send" command, as recited in claim 26.

Further, one of ordinary skill in the art would not be motivated to combine the teachings of Lazzouni and O'Conner. In order for a prima facie case to exist, the prior art must suggest the desirability of the claimed invention, providing to motivation to make a combination proposed the by the Examiner. *In Re Rouffet*, 149 F.3d 1350, 1357 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). In the instant rejection, the Examiner lacks any motivation to combine the teachings of Lazzouni with O'Conner. In the Office Action, the Examiner states that motivation is provided to combine the teachings of Lazzouni with O'Conner because "this would provide an improved compact pen computer interface which enables a user to conveniently and effectively utilize the pen for entering data to a computer". However, the Lazzouni pen system allows for a large amount of data to be stored in the separate base unit. There are no limitations with respect to size, power consumption, speed, etc. The combination of an internal memory unit as used in O'Conner into the system of Lazzouni would limit the memory capacity to the

amount of memory within the pen itself. This would impact the ability of Lazzouni's system to store large amounts of data.

Further, there is no suggestion within Lazzouni which would suggest modifying its teachings to utilize the teachings of O'Conner. Note that the mere fact that the references can be modified, does not render the results in combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916, F.2d, 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Certainly nothing within the references suggests or motivates the modification proposed by the Examiner.

In view of the above, applicants respectfully submit that the combination of Lazzouni and O'Conner fail to satisfy the requirements for the rejection under 35 U.S.C. §103. As indicated above, the combination of Lazzouni and O'Conner fail to teach each and every feature of the claimed invention and lack motivation to combine the teachings. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

### Conclusion


For at least these reasons, it is respectfully submitted that claims 1-30 are distinguishable over the cited references. Favorable consideration and prompt allowance are earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad J. Billings (Reg. No. 48,917) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s)

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